

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN A. MARTA

Appeal No. 2004-1219
Application No. 10/115,632

HEARD: August 18, 2004

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 6 and 10 to 12, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a device for the play of craps housed in and played substantially as a conventional slot machine (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1 to 6 and 10 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Moore, Jr.¹ (Moore) in view of the appellant's admission of prior art (specification, page 2, line 6, to page 7, line 15) relating to the conventional game of craps (Admitted Prior Art).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 19, mailed October 1, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 18, filed July 16, 2003) and reply brief (Paper No. 21, filed November 3, 2003) for the appellant's arguments thereagainst.

¹ U.S. Patent No. 5,964,463, issued October 12, 1999.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). As a consequence of our review, we will sustain the rejection of claims 1 to 6 and 10 to 12 under 35 U.S.C. § 103 for the reasons which follow.

In accordance with 37 CFR § 1.192(c)(7), we have selected claim 1 as the representative claim from the appellant's grouping of claims 1 to 6 and 10 to 12 to decide the appeal on the rejection under 35 U.S.C. § 103. See page 4 of the appellant's brief.

Claim 1 on appeal reads as follows:

A slot machine gaming apparatus for play of the game of craps by a player, comprising:
a single, free-standing housing containing
means for simulating play of the dice game of craps^[2], and
means for tallying cumulative winning or positive outcomes of said play according to a predetermined schedule and the rules of said game,
and
means for displaying and paying out to said player the total winnings, if any, accrued during said play.

In the BACKGROUND OF THE INVENTION section of the application (pp. 2-4),
the appellant teaches that:

In the conventional game of craps, two standard, matched dice are used. The players start the game by rolling for "high dice" and the player who rolls the highest total on the two dice plays the game first, becoming the "shooter" (or the "roller" or "caster") Variations on the casino play of the game are discussed more fully below.

Initially, the shooter may bet any desired amount. He announces his bet and places it on the playing surface, generally in the center of the surface being played upon. The shooter's bet may be accepted, or "faded", in whole or in part, by any other player. Each player, in turn to the caster's left, may take (fade) as much of the shooter's bet as he wishes, with precedence accorded to a player willing to fade the entire bet.

² The American Heritage® Dictionary of the English Language, Third Edition, 1992, defines "craps" as "[a] gambling game played with two dice in which a first throw of 7 or 11 wins, a first throw of 2, 3, or 12 loses the bet, and a first throw of any other number (a point) must be repeated to win before a 7 is thrown, which loses both the bet and the dice." This is the broadest reasonable meaning of the term "craps" as it would be understood by one of ordinary skill in the art, taking into account the enlightenment afforded by the written description contained in the appellant's specification. See *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

When the bet is faded, the shooter rolls the dice from his bare hand, no cup ever being used, shaking them before rolling, generally producing clicking to assure the other players that he is not casting them in a preset position or mode.

Under the rules of the game, if the faces of the two dice add up to 7 or 11 on the first roll, that is termed a "natural", and the shooter wins immediately. He collects the bets and keeps the dice, and the betting and fading proceed to the next roll of dice.

However, if the total on the dice at the first cast is 2, 3 or 12, that outcome event is termed "craps" or "crapping out", and the shooter loses, but he keeps the dice.

If the total shown on the first roll is any other of the possible numbers--4, 5, 6, 8, 9 or 10--the number shown on the dice becomes the shooter's "point". At this stage of play, the shooter has neither won nor lost. He continues to roll until either: (a) the dice repeat the same number, that is, he makes his point, in which case he wins, or (b) the dice rolled total 7, in which case he loses and the dice pass to the next player on his left, who becomes the new shooter.

A winning roll, whether from a natural or from making a point, is called a "pass". After each pass, the shooter may change his bet.

In usual play, side bets are permitted. That is, having rolled a point, the shooter bets additionally on whether or not he will make his point, and other players may bet on the same question among themselves. To win consistently, a player must be cognizant of the odds available at each throw of the dice.

In most games, there is continual action in betting. If the shooter rolls a point, he may additionally bet on the series of rolls beginning with his next roll, which are called "come" or "don't come" bets. He may bet that he is "right" or "wrong", meaning that he will shoot a winning number or crap out, respectively, in the next roll. These designations may have different meanings in different localities, so the player should ascertain the meaning of these terms at the location of play.

The appellant's specification states (p. 7) that:

The present invention provides, in slot-machine format, all of the thrills associated with the play of the game of craps and is similar, in every respect, to the play of the game at a casino craps table. Eliminated in the device of the invention are all biases in favor of the house such as those arising from biased dice or an overly skilled croupier. In fact, in the play of the game according to the invention, human intervention is eliminated completely.

Other casino games, and even pari-mutuel horse racing, have been adapted so as to be played in slot-machine-like devices. For example, poker, keno, lotto and bingo all have slot-machine counterparts to be found in the patent literature (see, e.g., U.S. Pat. Nos. 5,935,002 and 5,800,269). No known reference, however, discloses or suggests play of the game of craps, in all its significant detail, in the configuration of a slot machine.

Moore's invention relates generally to dice games utilizing two dice outputs to generate numbers based multiple repetitions or a count of numbers prior to novel termination and payout events. Moore's invention may be used on a traditional craps table or on a Four The Money Table. Moore's dice game may be embodied in a table or slot machine format. The preferred embodiment differs from traditional craps in that there is no requirement of a repeated number roll for a win. In one embodiment, a number other than seven, the target number, can be rolled on two six sided dice, numbered on sides from 1-6, in a tournament style fashion over a selected calendar period to win the primary wager. These games include counting the rolls on different players and comparing those rolls and making an award to the player making (a) the most rolls, (b) the most points, (c) the fewest points or rolls or (d) enhanced pay outs for

higher targets during a limited (e.g., 4) number of dice rolls. The invention also envisions the addition of points in a given number of rolls to generate a total which is compared to a central number or to reach certain specific numbers. A video (slot) game (i.e., slot machine format) is disclosed which replaces traditional displays with multiple dice rolls in a novel fashion otherwise consistent with Moore's disclosure.³

The Admitted Prior Art teaches the conventional game of craps.⁴

In the rejection before us in this appeal, the examiner determined (answer, p. 4) that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Moore's video (slot) game by replacing the dice game of Moore with the conventional game of craps in order to allow a player to play the conventional game of craps on the video (slot) game of Moore.⁵

³ Thus, Moore's dice game differs from the conventional game of craps.

⁴ Note the BACKGROUND OF THE INVENTION section of the application quoted above.

⁵ Implicit in this rejection is the examiner's view that the above noted modification of Moore would result in an apparatus which corresponds to the apparatus recited in claim 1 in all respects.

The appellant argues throughout both briefs that there is no suggestion, teaching or motivation to combine the applied prior art.⁶ The appellant further argues that no reference suggests the conventional game of craps simulated in a slot machine and that Moore teaches away from the claimed subject matter. We find these arguments unpersuasive for the reasons which follow.

First, while no single reference teaches or suggests the playing of the conventional game of craps on a slot machine, there is no requirement for such a reference in a rejection under 35 U.S.C. § 103.⁷ As stated above, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. As such, the issue before us is whether the combined teachings of the applied prior art (i.e., Moore and the Admitted Prior Art) teaches or suggests the playing of the conventional game of craps on a slot machine.

Second, Moore does not teach away from the claimed subject matter. As to the specific question of "teaching away," our reviewing court in In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated "a reference will teach away if it

⁶ The appellant does not dispute that the above noted modification of Moore would result in an apparatus which corresponds to the apparatus recited in claim 1.

⁷ In that regard, if such a reference existed it is likely that such a reference would anticipate claim 1 under 35 U.S.C. § 102.

suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In this case, Moore does not teach or suggest that the conventional game of craps would not work in a slot machine. Instead, Moore teaches dice games different from the conventional game of craps. Moreover, Moore teaches (column 7, lines 18-19) that "the subject game could be incorporated completely or in part with a pre-existing craps game." As such, it is our view that Moore suggests a slot machine which can play both Moore's dice games and the conventional game of craps.

Lastly, it is our opinion that there is sufficient suggestion, teaching or motivation in the applied prior art to arrive at the subject matter of claim 1.⁸ In that regard, Moore clearly teaches that dice games can be embodied in either a table or slot machine format.⁹ In view of this teaching of Moore, it is our conclusion that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to

⁸ Motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

⁹ The appellant admits (specification, p. 8) that other casino games (e.g., poker, keno, lotto and bingo) have been adapted so as to be played in slot-machine-like devices.

have embodied the conventional game of craps in a slot machine for the self evident advantages thereof.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is affirmed. In accordance with the above-noted grouping of claims, claims 2 to 6 and 10 to 12 fall with claim 1. Thus, it follows that the decision of the examiner to reject claims 2 to 6 and 10 to 12 under 35 U.S.C. § 103 is also affirmed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 6 and 10 to 12 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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